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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,145	01/31/2001	Tetsuo Yoshida	Q62887	1868

7590 07/15/2003

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[REDACTED] EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

11

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>
	09/762,145	YOSHIDA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Betelhem Shewareged	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 April 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-10,12-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 2,12-24 and 26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 4-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's response filed on 04/24/2003 has been fully considered. The claim objections, the 35 U.S.C. 112 rejections, and the 35 U.S.C. 102 rejection have withdrawn in view of Applicant's submission of the requested documents, amendments and comments.
2. Claims 3, 11 and 25 are cancelled, claims 1 and 4-10 are amended, and claims 1, 2, 4-10, 12-24 and 26 are pending. (NOTE: Claims 2, 12-24 and 26 are still withdrawn from consideration).

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (US 6,420,010) in view of Fukuda et al. (US 5,958,552).

Hasegawa discloses a white laminated polyester film, wherein one of the layers i.e. layer A comprises a polyethylene terephthalate, up to 10 % by wt of titanium oxide having an average particle diameter of 0.1-0.5 um and 0.01-0.1 % by wt of silicon dioxide having an average particle diameter of 0.6-2.0 um (col. 3, lines 21-35). The intensity ratio of the film is grater than or equal to 0.15 and smaller than or equal to 0.4 (col. 8, line 9), and the film has frictional coefficient smaller than 0.35 (col. 6, line 55).

The film has surface roughness of 0.08-0.103 um (col. 6, line 53) and a molecular orientation ratio of 1.0-1.5 (col. 8, line 37).

With respect to glossiness and optical density value it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Hasegawa reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Since Hasegawa is silent regarding thermal heat shrinkage value the examiner interprets the value to be zero, which falls within the claimed range, that is 2% or less.

Fukuda teaches a polyethylene terephthalate film to be used as a base sheet for an ink jet printing, wherein the film comprises silica and titanium oxide (col. 1, line 19; col. 2, lines 46-58 and col. 4, line 51). The film has a thickness of the film is 50-150 um (col. 5, line 44).

Hasegawa and Fukuda are analogous art because they are from the same field of endeavor that is the polyester film art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of the film thickness of Fukuda with the invention of Hasegawa so as to provide a polyester film that can be fed into a conventional ink jet printer. The polyester film has to be thick enough to avoid jamming and thin enough to avoid folding in the printer.

***Response to Arguments***

5. Applicant's argument is based on that Hasegawa contains no disclosure regarding any use of the Hasegawa laminated film in the ink jet printer environment. This argument is not found persuasive because Applicant's argument is based on an intended use, that is Applicant points out that Hasegawa's film is not used for ink jet printer. However, the claimed film is not limited to ink jet printer use only. The preamble of the claimed invention does not state a white biaxially oriented polyester *ink jet recording* film. Currently, the claimed white biaxially oriented polyester film may or may not be used as a base film for receiving an ink jet printer image.

Applicant further argues that Fukuda contains no disclosure regarding any features of the base film of the claimed invention. This argument is not found persuasive because Hasegawa teaches the claimed film except the thickness, and the reference of Fukuda is combined with Hasegawa to show the teaching of the film thickness not to replace the entire invention of Hasegawa.

For the above reasons the 35 U.S.C 103 rejection is keep and claims 1 and 4-10 are included in the rejection.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Betelhem Shewareged  
July 9, 2003.